



# UNITED STATES PATENT AND TRADEMARK OFFICE

*m*

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/079,447

02/20/2002

Thaddeus John Gabara

290-051us

9168

7590

05/12/2004

Joseph B. Ryan  
Ryan, Mason & Lewis, LLP  
90 Forest Avenue  
Locust Valley, NY 11560

EXAMINER

LEE, GRANVILL D

ART UNIT

PAPER NUMBER

2825

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/079,447

Applicant(s)

GABARA ET AL.

Examiner

Granvill D Lee, Jr

Art Unit

2825

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,9-11,13,18-20,22 and 23 is/are rejected.
- 7) ☒ Claim(s) 2-4, 6-8,12,14-17,21&24-26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 60/270,263.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Applicant's Argument***

After review of applicant's amendments and comments, the examiner finds such arguments unpersuasive. Applicant's comments as to Chang et al. are well taken, however in further review of the prior art, the examiner has found that Heijningen read upon applicant's claimed invention. As these are a new grounds for rejection not necessitated by applicant's amended claimed invention, and they are to be considered non-final rejections of the claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Heijningen (Pub.).

In view of these claims, Heijningen discloses a method of evaluating the performance of a hybrid analog-digital integrated circuit (Abstr.) having an

Art Unit: 2825

analog unit, a digital unit, and a substrate (Pg. 1005 1<sup>st</sup> para.) on which the units are located, comprising:

identifying a broadband (Sect. IV (a) 2<sup>nd</sup> para.) power source (Sect. III 2<sup>nd</sup> para.) that represents noise characteristics of the digital unit (Sect. III 2<sup>nd</sup> para.);

simulating performance of an integrated circuit using a lumped circuit (Sect. III 1<sup>st</sup>) in which the source couples to a lumped element representing the substrate (Sect. III 2<sup>nd</sup>) and the substrate couples to a lumped element representing the analog unit (Sect. IV (a) 2<sup>nd</sup> para.).

Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Feldmann et al. (US Pat. 6,135,649).

In view of this claim, Feldmann et al. teaches a digital circuit (Fig. 1a #10& 1b #100) from an integrated circuit, which determines the power coefficient of noise  $P_i$  (Col. 6 lines 50-65) to predict a power spectral density  $P(s)$  from the digital circuit and then fabricating a circuit based on the circuit when the digital circuit achieves a design goal for the integrated circuit.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2825

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-11, 13, 18-20, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feldmann et al. (US Pat. 6,135,649) in view of Chang et al. (US Pat. 6,075,770).

In view of claims 9-10 and 18-19 and 23, Feldmann et al. teaches a digital circuit from an integrated circuit, which determines the power coefficient of noise  $P_i$ , to predict a power spectral density  $P(s)$  from the digital circuit, but fails to discuss a mean bit rate. Chang et al. mentions mean bit rate as a method of determining new communication.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the power spectral density of Feldmann et al. with the deterministic method of Chang et al. with the expectation of determining a node for new communication. Chang et al. developed a method to determine whether or not a node was needed, which would utilize the mean bit rate data (Col. 4 lines 30-45).

In view of claims 11, 13, 20 and 22, Feldmann et al. discloses an both digital and analog circuits (Col. 4 lines 15-40).

***Allowable Subject Matter***

Claims 2-4, 6-8, 12, 14-17, 21 and 24-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Contact Information***

Any inquiry concerning this communication or earlier communications for the examiner should be directed to Granvill Lee whose telephone number is (571) 272-1897. The examiner can be normally reached on Monday, Wednesday, Thursday and Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are not successful, the examiner's supervisor, Matthew Smith can be reached on (571) 272-1907. The fax phone number for this group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

Art Unit: 2825

<http://pair-direct.uspto.gov>. Should you have questions on access to the

Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner  
Granvill Lee  
Art Unit 2825

GI  
4/3/04



LEIGH M. GARBOWSKI  
PRIMARY EXAMINER